



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/574,069

09/11/2006

Karin Golz-Berner

3975049

9418

86000

7590

11/19/2010

Gregory A. Nelson

Novak Druce & Quigg LLP

525 Okeechobee Blvd

Suite 1500

West Palm Beach, FL 33401

EXAMINER

SHOMER, ISAAC

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

11/19/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|----------------------------------------------------------------------------------------------|----------------------------------------------|---------------------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/574,069</p> | <p>Applicant(s) GOLZ-BERNER ET AL.</p> | |
| | <p>Examiner ISAAC SHOMER</p> | <p>Art Unit 1612</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 11-14 and 17.
Claim(s) withdrawn from consideration: 18-20.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jeffrey S. Lundgren/
Primary Examiner, Art Unit 1639

Continuation of 11. does NOT place the application in condition for allowance because: In applicant's arguments dated 9 November 2010 (hereafter referred to as applicant's arguments), applicant contends that the claimed composition unexpectedly provides a synergistic effect that results in an increased state of microcirculation when applied to the skin, as of applicant's arguments, page 5, first full paragraph. Applicant contends that the only cited reference that mentions jade is Roller, and Roller discussed jade in the context of eye shadow and does not teach jade stones in the size from 50 nm to 90 nm, as of applicant's arguments, page 5, last full paragraph. Applicant further contends that the results of the claimed combination were unexpected, as of applicant's arguments bridging pages 5 and 6. The examiner disagrees that applicant has shown either unexpected results or a synergistic effect. As pointed out in the final rejection dated 26 August 2010, applicant has tested a composition comprising the claimed elements (TS2) against the claimed elements individually (TS1 and B), as well as a control composition (A). See Figures 1 and 2 of the instant application, as reproduced on Figures 4 of the final rejection. However, the data are not probative of a greater than additive effect, as the curve for TS2 is not significantly greater than that for TS1. As such, the unexpected results are not statistically significant, see page 6, last full paragraph of the final rejection. Nothing presented in applicant's arguments on 9 November 2010, as applicant's statement that adding an electret clearly enhances skin cells' ability to absorb nutrients and active substances, as of page 6 paragraph 0031 of the specification, is not substantiated by actual evidence. Applicant's arguments in regard to Roller's teachings are not persuasive. Roller teaches a cosmetic comprising up to 5% jade particles, which overlaps with the claimed concentration of jade particles. Furthermore, the skilled artisan would have been motivated to have decreased the size of the size of the jade particles based upon the teachings of Graf. See pages 3 and 4 of the final rejection.